

REMARKS

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-3, 6, 10-14, 16-18, 19, 22-29, 33-37, 39, 43-44, 46-47, (48? sic), 50, 56-58, 65, 66 and 68 under 35 U.S.C. 103 as being unpatentable over U.S. Patent Number 5,313,635 (the '635 patent) issued to *Ishizuka et al.* The Examiner further rejected claims 7-9, 15, 30-32, 40-42, 45, 53-55, 62-64 and 67 under 35 U.S.C. 103 as being unpatentable over U.S. Patent Number 5,313,635 (the '635 patent) issued to *Ishizuka et al.* as applied to claims 1, 14, 27, 34, 33, 38, 56, and 66 above, and in further view of U.S. Patent Number 6,324,648 (the '648 patent) issued to *Balassanian*. Each of the independent claims, claim 1, 19, 27, 34, 48 and 56, stand rejected as being unpatentable over the '635 patent in spite of the Examiner's repeated admission that it fails to teach or suggest "the step of compiling in the second subsystem generates machine-executable code." See paragraph 6 as applied to claim 1 on page 3 of the Office Action. The Examiner has attempted to remedy this deficiency in the teachings of the '635 patent by asserting: "However, in view of *Ishizuka*'s disclosing of an object file via col. 3, lines 14-19; Fig 5a-b, one of ordinary skill in the art would recognize the availability of and the tight association between such object files and such necessary linked libraries at hand within the compiling environment, by which the object files can be assembled and/or linked into machine-executable code." See paragraph 6 as applied to claim 1 on page 3 of the Office Action.

Each of the independent claims recite limitations related to the creation of executable software by requiring the transmission compilation information from a first subsystem to a second subsystem, the compilation of computer program code into machine-executable code on

the second subsystem based on the compilation information received from the first subsystem, and receipt of the machine-executable code from the second subsystem by the first subsystem.

The cited passage from the '635 patent found at col. 3, lines 14-19 recites:

“The machine requested to compile the source program collects the necessary libraries from the library-installed machine by scanning the transmitted library-installed machine information to compile the source program and link the libraries. Then, the machine transfers a resultant object file to the client.”

Applicants do not believe the Examiner has established a *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met, namely: 1) suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings; 2) a reasonable expectation of success; and 3) the references, when combined must teach or suggest all the claim limitations. See In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143 *et seq.*

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Id. The mere fact that the references **can** be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. A prior art reference must be considered in its entirety, including portions that lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983).

Applicants believe the Examiner has failed to establish at least the first and second factors, if not all three factors, listed above for a *prima facie* case of obviousness. Nothing within the '635 patent teaches or suggests the creation of executable code, only object files. Any final step to create executable code from object files is lacking. In addition, there is nothing in the prior art of record to suggest a motivation to combine these features and to suggest a likelihood of success in such a combination. The use of the instant invention, its disclosure and claims, may not be used to suggest the desirability of the examiner's improper combination of teachings.

As such, applicants respectfully request that the Examiner establish a *prima facie* case of obviousness for the Examiner's suggested combination or withdrawal of the rejection. In view of the above arguments, Each of the independent claims, claim 1, 19, 27, 34, 48 and 56, are patentable over the prior art of record. The remaining claims, claims 2-28, 20-26, 28-33, 35-37, 49-55, and 57-68, all depend from one of the above independent claims. Therefore, these dependent claims recite additional limitations that further distinguish the dependent claims from the '635 patent. As the Examiner implicitly states in his rejection, the '685 patent does not remedy the above deficiency with the '635 patent. The dependent claims are also patentable over the prior art of record for at least the reasoning stated above.

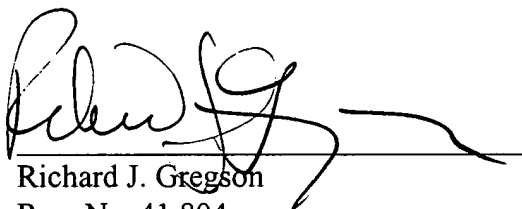
CONCLUSION

In view of the above, it is submitted that all claims are in condition for allowance. Applicants request reconsideration, withdrawal of the rejections, and a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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